Supreme Court, U. S.
FILED
NOV 20 1974
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-6201

EDWARD S. IRONS,
Petitioner,

v.

COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Petitioner prays that a writ of certiorari issue to review the rulings of the United States Court of Appeals for the District of Columbia Circuit entered September 23 and October 18, 1974.

OPINIONS BELOW

The orders of the United States Court of Appeals for the District of Columbia Circuit dated September 23, 1974 and October 18, 1974 which are unreported, are reproduced *infra*, 1a and 2a. The memorandum order of the United States District Court for the District of Columbia dated January 10, 1974, (*infra* 3a to 15a) is reported at 396 F. Supp. 403. The subsequent memo-

randum order of the district court dated March 11, 1974 (*infra* 16a to 20a) is unreported.

JURISDICTION

The order of the United States Court of Appeals for the District of Columbia Circuit refusing to vacate the opinions below and remand for a fair hearing before a different judge was entered September 23, 1974 (1a). A timely petition for rehearing *en banc* was denied October 18, 1974 (2a). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. What is the minimum standard of judicial conduct required by the Fifth Amendment's due process clause in civil federal question cases to insure a fair hearing before an impartial tribunal?

   (a) Specifically, what are the respective relationships of (i) 28 U.S.C. 455 and (ii) the Code of Judicial Conduct (especially Canons 2 and 3) to that minimum standard?

   (b) Is the minimum standard relaxed in any way (i) because an officer of the United States Government in his capacity as such is the defendant, or (ii) relative to plaintiffs in cases arising under the Freedom of Information Act, 5 U.S.C. 552?

2. May a federal judge who has rendered a decision revealing that he sought and obtained evidence on which to base it from one litigant, *ex parte* and without notice to the other, in derogation of Judicial Canons 2(A) and 3(A)(4), deny a timely motion to recuse himself and vacate the offending decision?

CONSTITUTIONAL, STATUTORY AND OTHER PROVISIONS INVOLVED

This case involves construction of the Due Process Clause of the Fifth Amendment to the Constitution and its relationship to 28 U.S.C. 455 and Canons 2 and 3 of the Code of Judicial Conduct.

The Fifth Amendment is as follows:

> "No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offence to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation."

28 U.S.C. 455 provides:

> "Any justice or judge of the United States shall disqualify himself in any case in which he has a substantial interest, has been of counsel, is or has been a material witness, or is so related to or connected with any party or his attorney as to render it improper, in his opinion, for him to sit on the trial, appeal, or other proceeding therein."

Judicial Canons 2 and 3 are set forth in their entirety *infra*, pp. 21a to 28a; generalized Canon 2 and its corollary 2A are as follows:

> "*Canon 2. A Judge Should Avoid Impropriety and the Appearance of Impropriety in all his Activities.*
>
> A. A judge should respect and comply with the law and should conduct himself at all times in a manner that promotes public confidence in the integrity and impartiality of the judiciary."

Generalized Canon 3 and its corollaries 3A(4), 3C(1)(a) and 3D are as follows:

"*Canon 3. A Judge Should Perform the Duties of his Office Impartially and Diligently.*

"The judicial duties of a judge take precedence over all his other activities. His judicial duties include all the duties of his office prescribed by law. In the performance of these duties, the following standards apply:

"A. *Adjudicative Responsibilities.*

* * * *

(4) A judge should accord to every person who is legally interested in a proceeding, or his lawyer, full right to be heard according to law, and, except as authorized by law, neither initiate nor consider *ex parte* or other communications concerning a pending or impending proceeding. A judge, however, may obtain the advice of a disinterested expert on the law applicable to a proceeding before him if he gives notice to the parties of the person consulted and the substance of the advice, and affords the parties reasonable opportunity to respond.

* * * *

"C. *Disqualification.*

(1) A judge should disqualify himself in a proceeding in which his impartiality might reasonably be questioned, including but not limited to instances where:

(a) he has a personal bias or prejudice concerning a party, or personal knowledge of disputed evidentiary facts concerning the proceeding;

* * * *

"D. *Remittal of Disqualification.*

A judge disqualified by the terms of Canon 3C(1)(c) or Canon 3C(1)(d) may, instead of withdraw-

> ing from the proceeding, disclose on the record the basis of his disqualification. If, based on such disclosure, the parties and lawyers, independently of the judge's participation, all agree in writing that the judge's relationship is immaterial or that his financial interest is insubstantial, the judge is no longer disqualified, and may participate in the proceeding. The agreement, signed by all parties and lawyers, shall be incorporated in the record of the proceeding."

The Freedom of Information Act, 5 U.S.C. 552, which is only incidentally involved in this petition, is reproduced *infra*, 29a to 32a.

STATEMENT OF THE CASE

The questions before this Court arose in the context of an action to obtain access to certain Patent Office records under the Freedom of Information Act, 5 U.S.C. 552. They are based on the *sua sponte* adoption by a district judge of *ex parte*, off the record consultation between his staff and Patent Office representatives as the means for resolving controverted fact issues on the merits, in the teeth of petitioner's continuously pressed objection to, and motion to strike, all Patent Office "evidence" as to which cross-examination and rebuttal were refused. Petitioner was given no advance notice or opportunity to be heard as to this unusual procedure, but was advised that it had been invoked *after* it was a *fait accompli* in a "memorandum order" dated January 10, 1974 (3a) which refused on the merits all but the most inconsequential portion of the relief then sought by petitioner,[1] admittedly partly on the basis of the *ex parte*, off the record consultation. Petitioner's promptly filed motion to vacate, recuse the judge and reopen proceedings be-

[1] See *infra*, pp. 11-14.

fore a different judge was denied in a further memorandum order dated March 11, 1974 (16a).

Petitioner appealed on March 18, 1974 and moved for summary reversal of the March 11, 1974 order refusing recusal and to remand for a fair hearing before a different judge. This motion was denied on September 23, 1974 (1a) by a two-judge appellate panel without hearing or opinion. A timely petition for rehearing *en banc* was summarily denied *per curiam* on October 18, 1974, again without hearing or opinion (2a).[2]

To put the questions in perspective, a brief review of the history of this action is in order.

The original complaint in this case was filed January 12, 1970 by petitioner, an experienced patent lawyer. It sought access under 5 U.S.C. 552(a)(2) to all then existing unpublished decisions of Patent Office tribunals (known as "manuscript decisions" within the agency and to patent practitioners) "together with such indices as are available".[3] It also sought an order directing the defendant Commissioner of Patents to maintain and make

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[2] The appellate court has thus finally refused petitioner the right of a fair trial before a different judge. The September 23, 1974 order moreover directed petitioner to file a brief on the merits of the questions purportedly decided by the January 10, 1974 memorandum order within 15 days.

Petitioner being disabled to meet the district court's fact findings, many of which are *challenged*, in the circumstance that he has not been fully informed of the premises—adduced in *ex parte* off the record consultation with the Patent Office—on which they rest, nor permitted to advance evidence to meet and rebut them, has succeeded in obtaining a postponement to November 22, 1974 to permit the filing of this petition and has advised the appellate court that once the petition is filed, an additional extension will be sought until 20 days after its disposition in this Court.

[3] The complaint appears at pp. 5-7 of the D.C. Circuit appendix in No. 24,742. A copy of that appendix and the one in D.C. Circuit Appeal No. 74-1365 from which this petition is taken, have been lodged with the Clerk of this Court.

available for public inspection an index of all manuscript decisions rendered after July 4, 1967, pursuant to the mandate of 5 U.S.C. 552(a)(2).

During subsequent proceedings in the district court, petitioner was foreclosed by the trial judge from taking discovery despite attempts to do so. In an opinion and order dated October 25, 1970, reported at 321 F.Supp. 628, the district court directed the Commissioner of Patents to prepare an index of post-July 1967 decisions and make is publicly available, but otherwise dismissed the complaint summarily on the ground of interdiction by 5 U.S.C. 552(a)(3) because "not a reasonable request for identifiable records, but rather a broad, sweeping, indiscriminate request for production, lacking any specificity." (321 F.Supp. at 629).

On appeal the United States Court of Appeals for the District of Columbia Circuit affirmed in an opinion of June 15, 1972, which relied strongly upon a challenged *ex parte* affidavit of Raymond E. Martin, a Patent Office employee and member of the Patent Office Solicitor's staff to hold that "the contours of the records thus described are so broad in the context of the Patent Office files as not to come within a reasonable interpretation of 'identifiable records'" under § 552(a)(3).[4] See *Irons* v. *Schuyler*, 465 F.2d 608, 613 (D.C. Cir. 1972), certiorari denied, 9 U.S. 1076 (1972).

The opinion nevertheless held that "appellant is entitled to a remand" for consideration of the complaint's request for access to pre-existing indices and stated:

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[4] The district court opinion thus purportedly "affirmed" does not mention the Martin affidavit or any facts it purportedly shows.

The holding as to "identifiable records" is flatly in conflict with the Fourth Circuit's construction of that term. See *Wellford* v. *Hardin*, 315 F. Supp. 175 (D. Md. 1970), *aff'd* 444 F.2d 21 (4 Cir. 1971); *Ethyl Corp.* v. *Environmental Protection Agency*, 478 F.2d 47 (4 Cir. 1973) and *Sears* v. *Gottschalk*, 502 F.2d 122 (4 Cir. 1974), certiorari pending as No. 74-584 on unrelated points of law.

". . . There appears to be some difference between the parties as to the facts regarding these indices. The District Court will have in mind, should the parties be unable to agree, whether those differences preclude resolution of the matter by summary judgment. We of course leave open the question whether the remand for consideration of the request for indices might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion should motion to that end be made." (465 F.2d at 614).

In a timely filed motion to withdraw opinion and vacate judgment petitioner on June 26, 1972 brought to the attention of the appellate court certain facts demonstrating the Martin affidavit to be at least partially false. The Patent Office did not controvert. The court of appeals was careful, in its supplemental opinion on petition for rehearing filed August 21, 1972, to avoid further reference to the challenged Martin affidavit and to emphasize that the problem was one of definition of the requested unpublished decisions. The appellate court specifically suggested that:

". . . In the developments on remand with respect to the indices, it may be that sufficient light will be shed upon the problem to enable a request for the manuscript decisions to be made in a manner which brings it within the Act. *In camera* inspection by the court of the indices and contents of volumes of manuscript decisions which the record indicates may exist, is not precluded, to aid the court in passing upon the issue of disclosure and the related issue of exemptions. With the cooperation of the parties in preserving whatever non-disclosure the exemptions authorize, while at the same time seeking compliance with the purpose of the Act to inform the public as to the manner in which public agencies

perform their functions, a satisfactory solution hopefully can be achieved on the remand." (465 F.2d at 615).

On remand, the district court again refused to permit petitioner to obtain discovery. In particular, the judge thrice frustrated petitioner's efforts to take the deposition of the Patent Office affiant Martin to explore the "difference between the parties as to the facts regarding . . . indices" noted by the appellate court, to cross-examine him on his sworn and unsworn *controverted* representations of fact to the district court or for any other purpose. The Commissioner was nevertheless permitted to advance as evidence of controverted facts, over petitioner's continuous objection, both the original, concededly *at least* partially false, Martin affidavit, a *second* also controverted Martin affidavit and self-serving unsworn alleged "fact" statements in Patent Office briefs.

Specifically, the district judge first issued a written order granting a Patent Office motion to quash a deposition notice and subpoena to the witness Martin on May 7, 1973. When orally asked to reconsider on May 10, 1973 the judge summarily refused, stating: "Mr. Martin is counsel. I don't permit deposition of counsel to be taken. . . . Mr. Martin is counsel for the Patent Office. I don't think he should be deposed. . . . I don't think it is proper to take the deposition of counsel" (Appendix in D.C. Cir. No. 74-1365 at p. 76).

The right to take the Martin testimony was again refused in the January 10, 1974 memorandum order wherein petitioner's written motion to reconsider the abovementioned May 7, 1973 order was "denied as moot" (15a).[5]

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[5] The characterization of this motion as "moot" necessarily depends on the district court's substitution of its own off the record investigatory foray for petitioner's right to meet and rebut the Patent Office "evidence", *inter alia*, by deposing Mr. Martin.

Importantly, the sole hearing in the district court after remand which was held May 10, 1973 and is referred to in the January 10, 1974 memorandum order (4a) *preceded* the filing of petitioner's two contempt motions, his motion for leave to file a second amended complaint[6] and his motion for partial summary judgment, each of which the memorandum order, *after* the district court's *ex parte* consultation with the Patent Office, flatly denied except in one minor detail.[7]

Petitioner has not been informed as to the names of persons who actually took part in the off-the-record consultation on November 30, 1973 between at least one member of the court's staff and Patent Office representatives in Suitland, Maryland and Arlington, Virginia, nor does petitioner have access to facts showing the nature of the discussions, the precise identity of *all* records actually inspected, the oral explanation which accompanied their display or the like. The district judge in refusing to recuse himself self-servingly characterized the excursion as "a physical identification of material" (19a), "a physical inspection of certain items" (20a), but failed to indicate the nature of the associated commentary or other aspects of the full circumstances which would permit assessment of that characterization's accuracy. The district judge attempted to justify its short-circuiting of plaintiff's rights of cross-examination and rebuttal in this *ex parte*, off the record manner by opining self-servingly that "judicial economy and economy of the parties was served" (17a).

Notably, however, *before* the court's November 30, 1973 *ex parte* foray with the Patent Office representatives took

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[6] A proposed first amended complaint was withdrawn voluntarily before the district court ruled on it.

[7] To wit, the district court ordered production *only* of case name indices to bound volumes of unpublished decisions covering the years 1853 to 1923.

place, the Commissioner's own counsel acknowledged under oath in the *only* interrogatory answer ever furnished by defendant throughout the entirety of the litigation that *any ex parte* contact between Patent Office representatives and the court would be highly improper.[7]

After the *ex parte* consultation, the Commissioner never disputed that the irregular procedure invoked was in violation of the Code of Judicial Conduct nor denied that the judge had made himself a material witness within the meaning of 28 U.S.C. 455, but alleged that this was not prejudicial to petitioner, citing the release in the January 10, 1974 memorandum order of case name indices to the 1853 to 1923 bound volumes of unpublished decisions as a ruling "favorable" to petitioner.

This attitude overlooks the facts that in this January 10, 1974 memorandum order:

> (a) Petitioner's post-May 10, 1973 motion for partial summary judgment, based on a "statement of material facts as to which there is no genuine issue"[8] that the Commissioner *never* controverted, sought release in their entirety of (i) the manifestly "identifiable" *and identified 175 bound volumes* of un-

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[7] Plaintiff's Interrogatory 14 and defendant's answer are quoted in their entirety in the March 11 decision refusing to recuse and vacate the tainted January 10, 1974 order (19a). The district judge there avoided the real thrust of the interrogatory answer by incorrectly ascribing to petitioner an accusation that the answer was false at the time it was given, and then refuting his own straw man charge, which petitioner never made. Thus, the district court said:

> "Plaintiff accuses the United States Attorney of a false answer by assuming that an inspection by the Court's staff November 30, 1973, meant that there must have been some contact prior to November 15, 1973. In fact, plaintiff's assumption is wrong, and the answer of the United States Attorney was not, as plaintiff claims, a false one." (19a).

[8] This "statement of material facts. . ." is reproduced *infra*, 33a to 34a.

published decisions from 1853 to 1954, *including* their internal case name indices and (ii) the Patent Office docket card indices and the file wrapper jacket indices from which additional unpublished Patent Office decisions could be identified—and that the district judge *denied* this motion apart from the token release of internal case name indices for the 1853-1923 bound volumes.[10]

(b) The district court *denied* petitioner's post-May 10, 1973 contempt motion framed as a result of the Commissioner's admission in a brief filed May 23, 1973 that docket index cards had been willfully destroyed subsequent to the filing of the complaint in this action,[11] adopting a self-serving unsworn

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[10] The Commisisoner on March 15, 1974 filed but did not serve a notice of appeal from that portion of the January 10, 1974 memorandum-order, but never perfected the appeal. On June 25, 1974 a motion for leave to withdraw it was filed which the court of appeals on October 11, 1974 denied without prejudice to the filing of a similar motion in the district court.

[11] While the Patent Office was careful not to cite precise dates on which the docket index cards were destroyed, its admission was that those covering the period ended December 31, 1969—i.e., a period which expired 12 days before the complaint was filed—relative to abandoned applications and those covering the period up to December 11, 1973 (almost two years *after* the filing of the complaint) relative to allowed applications, had been destroyed as of May 23, 1973. These docket index cards were not only a part of the subject matter sought by the complaint but were material evidence indicating the location and identity of the manuscript decisions also sought by the complaint. *If* they had been maintained in existence, they would have put the lie to the Commissioner's representation before the court of appeals prior to remand that it would be necessary to search the file of every patent application in existence to find the requested manuscript decisions—a representation which petitioner consistently challenged on the basis of the existence of the docket index cards but was never permitted to prove. This challenged representation was at the core of the appellate affirmance of the *first* district court decision based on *the* allegedly *unidentifiable* character of the unpublished decisions.

[Footnote continued on page 13]

Patent Office representation in the same brief that these cards are not "meaningful indices" even though *no facts* have ever been adduced on the record to support that assertion.

(c) The district judge *denied* plaintiff's motion for leave to file its second amended complaint, carefully drawn *to define only "identifiable records" pursuant* to criteria set forth in the August 21, 1972 rehearing decision in the court of appeals (465 F.2d at 614-5).

(d) The district judge *denied* the petitioner's motion for a contempt citation because of the Commissioner's failure to comply fully with the district court's order of October 25, 1970 requiring indexing of post-July 4, 1967 decisions on the basis of (i) the *ex parte* inspection at Arlington, Virginia,[12] (ii) a misrepresentation of petitioner's position, contrary to the record, that "[p]laintiff makes no allegation that the Patent Office is not satisfactorily indexing its manuscript decisions . . ." (13a) in direct conflict with the statement of petitioner's counsel at the May 10, 1973 oral hearing that ". . . the index is deficient. It doesn't contain all the decisions. . . ."[13]

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[11] [Continued]

As this Court said in *Merrimack River Savings Bank* v. *City of Clay Center*, 219 U.S. 527 (1911):

> ". . . The willful removal beyond the reach of the court of the subject-matter of the litigation, or its destruction. . . is, in and of itself a contempt of the appellate jurisdiction of this court. "219 U.S. at 535-6."

See also *Clay* v. *Waters*, 178 F. 387, 391 (8 Cir. 1910).

[12] The January 10, 1974 memorandum decision flatly holds:

> "Upon inspection of the indices being maintained, the Court finds full compliance with the October 1970 Order". (13a).

[13] The quotation is from page 79 of the appellate appendix in No. 74-1365. The entire transcript of the May 10, 1973 hearing appears at pages 49-80 of that appendix.

and (iii) a clearly erroneous finding in the teeth of the complaint that "material referred to in 5 U.S.C. § 552(a)(2)(B) and (C) . . . . were never requested in plaintiff's original comp'aint, and as a result, they were not incorporated into the Order of October 26, [sic] 1970" (13a). *In fact* the prayer of the original complaint, paragraph (b) sought an order "requiring the defendant to maintain and make available for public inspection and copying a current index of manuscript decisions as required by 5 U.S.C. 552 (a)(2)".[1] Manifestly, 5 U.S.C. 552(a)(2) categorically *includes* all of its subparts A, B and C. The district court's October 25, 1970 order, moreover, is by its terms generic to *all of* "5 U.S.C. 552(a)(2)." See 321 F.Supp. at 629. The January 10, 1974 *nunc pro tunc* rewriting of this October 25, 1970 order to exclude manuscript decisions within the scope of 5 U.S.C. 552(a)(2)(B) and (C) in the face of *ex parte* off-the-record consultation with Patent Office representatives was *not* "favorable" to petitioner.

In the March 11, 1974 memorandum order the district judge did not deny that his conduct had been unethical or that he had effectively become a material witness for the Commissioner in contravention of 28 U.S.C. 455. He acknowledged that the challenged procedure was adopted because he "deemed it advisable to get a better perspective on the materials actually in issue" (17a)—or in other words, he needed evidence on controverted facts, but took the tack that petitioner had a burden to show "prejudice" consequent from the November 30, 1973 *ex parte* off-the-record consultation as a prerequisite to recusal. He then held this burden had not been dis-

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[1] See p. 7 of the appellate appendix in No. 24,742 of the District of Columbia Circuit.

charged,[15] though knowing full well that petitioner had no access to and no means even of adducing the full facts pertinent to those consultations, such facts being within the judge's own control and that of the Patent Office, and suppressed from petitioner by both.

Petitioner's position that he need not demonstrate any of the *ex parte* off-the-record consultation to have been specifically the basis for a finding of fact or conclusion of law adverse to him in view of the gross violation of the Code of Judicial Conduct and 28 U.S.C. 455 was wholly ignored by the district judge, as was petitioner's reliance upon the teachings of *Rapp* v. *Van Dusen*, 350 F.2d 806 (3 Cir. 1965) and *Texaco* v. *Chandler*, 354 F.2d 655 (10 Cir. 1965), both of which hold it to be among the requisites of a fair hearing that the judge not only avoid actual evil but the merest appearance of such evil in his conduct of the proceedings.

The subsequent summary appellate rulings, made without opinion, equally failed to deal with this important question.

REASONS WHY THE WRIT SHOULD BE GRANTED

(1) *The district court, with the approbation of the court of appeals, en banc, has so far departed from the accepted standards of procedure in civil litigation that review should be granted.*

Petitioner was deprived of the rights to confront Patent Office evidence presented at the Suitland, Maryland and Arlington, Virginia *ex parte* consultation on November 30, 1973 with the district court's staff, to meet such advocacy and argument as occurred during that *ex parte* consultation, to cross-examine the Patent Office affidavit

[15] The March 11, 1974 order specifically holds "The Court finds no element of prejudice to the plaintiff in the action of November 30, 1973." (20a).

witness Martin and to rebut the alleged evidence presented by the Commissioner on the record.

The denial of petitioner's motion to vacate filed promptly after the fact of *ex parte* consultation was revealed in the January 10, 1974 memorandum order (3a) is in the teeth of the procedural standards which this Court has held the Fifth Amendment alone to require in federal question cases generally and, when combined with the Fourteenth Amendment, in administrative and judicial hearings, both civil and criminal, in the states.

In *Goldberg* v. *Kelly*, 397 U.S. 254, 269-270 (1970) involving the right of a welfare recipient to notice and a hearing before termination of benefits, this Court emphasized that

> "In almost every setting where important decisions turn on questions of fact, due process requires an opportunity to confront and cross-examine adverse witnesses. *E.g., ICC* v. *Louisville & N.R. Co.*, 227 US 88, 93-94, . . . (1913); *Willner* v. *Committee on Character and Fitness*, 373 US 96, 103-104 . . . (1963). What we said in *Greene* v. *McElroy*, 360 US 474, 496-497 . . . (1959) is particularly pertinent here . . .":

In *Armstrong* v. *Manzo*, 380 U.S. 545,552 (1965), a case relied on by the majority in *Goldberg*, the Court unanimously voided a state court child custody award made without notifying the father or awarding him a hearing, saying

> "A fundamental requirement of due process is 'the opportunity to be heard.' Grannis v. Ordean, 234 US 385, 394, 58 L.Ed. 1363, 1369, 34 S. Ct. 779. It is an opportunity which must be granted at a meaningful time and in a meaningful manner. The trial court could have fully accorded this right to the petitioner only by granting his motion to set aside the decree and consider the case anew. Only

> that would have wiped the slate clean. Only that would have restored the petitioner to the position he would have occupied had due process of law been accorded to him in the first place."

Citing *Armstrong*, the Fifth Circuit in *Carter* v. *Morehouse Parish School Board*, 441 F.2d 380 (5 Cir. 1971) held that "A ruling based on evidence which a party has not been allowed to confront or rebut is one which denies due process." To the same effect, see *United States* v. *Cabbage*, 430 F.2d 1037 (6 Cir. 1970).

In *Frito-Lay, Inc.* v. *Morton Foods, Inc.*, 316 F.2d 298, 300 (10 Cir. 1963) cited by the Fifth Circuit in support of its ruling in *Carter*, *supra*, the Tenth Circuit reversed a trial judge's *sua sponte* summary disposition on the merits of a trademark infringement claim without hearing any of the proffered evidence, saying

> "We have had recent occasion to disapprove, but perhaps with insufficient emphasis, the summary disposition of causes through procedures not in accord with the Rules of Civil Procedure. Wirtz, Secretary of Labor v. Young Electric Sign Company, 10 Cir., 315 F.2d 326. And where, as here, a complex case is concluded upon its merits after what amounts to no more than the opening statement of counsel we must be clearly shown that the judgment is soundly based. '* * * An expedious disposition of cases is a cardinal virtue of the administration of justice, but it is not more important than one's fundamental right to his full day in court.' Arrick v. Rockmont Envelope Co., 10 Cir., 155 F.2d 568 573."

In similar vein the Fourth Circuit in *Miller* v. *United States*, 455 F.2d 833, 836 (4 Cir. 1972) held that claimants to an informer's share in fines levied against those convicted of violating the Refuse Act of 1899, 33 U.S.C. 411 were entitled to

> "... notice that their claim was being adjudicated, the right to confront and to cross-examine adverse witnesses, the right to participate in the proceedings by counsel and to adduce relevant, admissible evidence in their own behalf, and the right to a decision based upon evidence adduced at such a hearing."

The district court's essential holding in this case goes far afield from these established standards, with the approval of the court of appeals, to hold that the need for expeditious disposition is paramount and the right of a plaintiff to be heard of secondary importance, *at least* when the defendant is a functionary of the United States government or the case arises under the Freedom of Information Act.

(2) *The departure from accepted standards of procedure in civil litigation is aggravated by the district court's departure from accepted standards of judicial conduct.*

28 U.S.C. 455 requires that a judge of the United States "*shall* disqualify himself in any case in which . . . he has been a material witness. . . ." This Court has never defined the statutory limit nor expressed itself upon the subject of whether the statutory language negates the use of judicial discretion in determining whether disqualification shall be granted in response to a timely motion. In *Quercia* v. *United States*, 289 U.S. 468 (1933) and *In re Murchison* 349 U.S. 133 (1955), however, this Court granted relief by virtue of conduct which rendered a trial judge an actual or potential material witness for one side. In *Quercia* a new trial was granted because the trial judge added to the evidence before the jury by volunteering his own testimony that a defendant in a criminal case who wipes his hands during his testimony is almost always lying. In *Murchison*, the trial judge had conducted a secret "one man grand jury" investigation and being obviously unable to rid himself of the impressions gained thereby, had implicitly rendered himself

a potential material witness in any subsequent criminal contempt trial.

In this case, the judge did not deny that the procedure which he chose for resolving controverted facts effectively made him a material witness but attempted to justify his conduct as "vastly different" (20a) from that in *Murchison* because "this litigation has been long and difficult. Many motions have been considered, it has been heard by the court of appeals and again by this court on remand. An extensive record exists." (20a)[16]

In *Fillipon* v. *Albion Vein Slate Co.*, 250 U.S. 76, 81 (1919) this Court ordered a new trial in a case in which the judge had instructed the jury in writing on a matter of law in the absence of counsel for both parties, saying "We entertain no doubt that the orderly conduct of a trial by jury, essential to the proper protection of the right to be heard, entitles the parties who attend for the purpose to be present in person or by counsel at all proceedings from the time the jury is empaneled until its discharge after rendering a verdict."

Relying, *inter alia*, on *Fillipon*, the Third Circuit in *Arrington* v. *Robertson*, 114 F.2d 821, 823 (1940) held that

> "Orderly procedure requires that a plaintiff be accorded the same right [to be present in person or

[16] Actually, though the litigation has now been in existence for more than four years, it has hardly consumed much of the district court's time. The appellate appendix in No 24,742 shows that two brief oral hearings on June 1, 1970 and September 21, 1970 occurred prior to the October 25, 1970 dismissal order. The sole hearing after remand was on May 10, 1973 *prior* to the filing of the various motions purportedly disposed of in the January 10, 1974 memorandum order, at least partly on the basis of the *ex parte* off the record consultation with the Patent Office. The "extensive record"—to the extent the proceedings may properly be so characterized—is not evidentiary but consists of copies of motions, briefs and the like. See the appendices in D.C. Circuit Appeals 24,742 and 74-1365.

> by counsel at every stage of his trial]. A party or his counsel may waive this right expressly. He may also waive it by voluntarily absenting himself from the courtroom in which the trial is being conducted . . . but . . . the parties are entitled to anticipate and bound to presume, in the absence of notice to the contrary, that all such proceedings will take place in open court in the courtroom assigned for the trial and will be reported by the court stenographer. Consequently a party or his counsel who voluntarily absents himself from the courtroom consents to such proceedings only as take place in the courtroom during his absence but not to proceedings which take place elsewhere. . . ."

In *Rapp* v. *Van Dusen*, 350 F.2d 806, 812 (3 Cir. 1965), in a ruling quoted and followed by the Tenth Circuit in *Texaco, Inc.* v. *Chandler*, 354 F.2d 655 (10 Cir. 1965), it was emphasized that "litigants are entitled . . . to a judge whose unconscious responses in the litigation may be observed in the presence of all parties and their counsel."

Applying these established standards of judicial conduct which require the presence of counsel for both parties during presentation of both controverted facts *and* legal argument, this Court in *Murchison*, *supra*, the Third Circuit in *Rapp* and the Tenth Circuit in *Texaco*, all concluded that judicial conduct must in every case be such as to afford a hearing that not only *is fair* but *appears fair*, and accordingly disqualified trial judges from further participation in cases where their conduct was or appeared to be tainted.

In *Murchison*, this Court, quoting from *Offut* v. *United States*, 348 U.S. 11 (1954), specifically said that "to perform in the best way 'justice must satisfy the appearance of justice' " (349 U.S. at 136). In *Rapp* and *Texaco* it was emphasized that "the proper administration of justice

requires not only actual impartiality, but also the appearance of a detached impartiality." [17]

This requirement in judicial trials generally was simply brushed aside by the district judge who tacitly conceded at least the appearance of impropriety in his own conduct but deemed that his misconduct did not "prejudice" petitioner.

(3) *The role of the Code of Judicial Conduct adopted by the American Bar Association in 1972 relative to judicial behavior in litigated cases should be defined as a part of this Court's power and duty to supervise the conduct of proceedings in the lower courts.*

This Court—and in particular the Chief Justice—has several times recently noted the need for more rigorous enforcement of elementary standards of ethics and competence among members of the legal profession. Thus, for example, the Chief Justice in his August 8, 1974 letter to the president of the American Bar Association referred to the 1970 report to the ABA Special Committee on the Evaluation of Disciplinary Enforcement chaired by former Associate Justice Clark as presenting "a melancholy picture of the failure of our profession to enforce elementary standards of ethics in the relations between lawyers and their clients and between lawyers and the courts" and recommended that the matter be made "a priority measure on the agenda of the Association", emphasizing that "the legal profession is a generation behind the need to place its own house in order." Federal judges are, of course, a part of the legal profession. The ethical standards followed by such judges set the tone for the ethical performance of the whole profession. So long as less than proper conduct is tolerated among the

[17] These principles were applied by one district judge of the United States Court for the District of Columbia to disqualify himself in *United States* v. *Quattrone*, 149 F. Supp. 240 (D.D.C. 1957).

federal judiciary, it can hardly be expected that mere lawyers will, as a group, exact a higher standard of performance from themselves.

The 1972 Code of Judicial Conduct expressly interdicts the *ex parte* consultation which occurred in this case,[18] and mandates that judges shall disqualify themselves whenever "impartiality might reasonably be questioned" including when they have "personal knowledge of disputed evidentiary facts".[19] This case poses the highly important question of whether this Code of Judicial conduct—as a matter of common knowledge adopted at least in part in response to public pressure created by revelations made during the course of the Senate hearings on the confirmation to this Court of former President Nixon's unsuccessful nominees, Haynsworth and Carswell—has any real vitality.

The need for an expression by this Court as to the role of the Code of Judicial Conduct is underscored by the fact that the Court, in implementing its rulemaking powers under 28 USC §§ 2071 and 2072, has not seen fit to prescribe criteria for proper judicial conduct in the lower federal courts, leaving the matter instead to the slow pace of case by case development.[20] The American Bar Association's effort to fill the gap should either be approved or disapproved to the end that judges, lawyers and litigants will know whether the 1972 Code is a meaningful yardstick by which to measure the propriety of judicial conduct, or just another exercise in legal drafting.

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[18] See Judicial Canons 2A and 3A4, *supra*, pp. 2-3.

[19] See Judicial Canon 3C1(a) quoted *supra* 4. Judicial Canon 3D, *supra* pp. 4-5, defines the only conditions under which remittal of disqualification is permissible and affords *no* remittal under any circumstance for activities of the character that occurred in this case.

[20] As, *e.g.*, in *Murchison*, *Quercia*, *Fillipon* and similar actual cases.

CONCLUSION

The writ should be granted,

Respectfully Submitted,

MARY HELEN SEARS
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Washington, D.C. 20006
296-8855

Attorney for Petitioner

ORDER OF SEPTEMBER 23, 1974

BY THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Before: Leventhal and MacKinnon, Circuit Judges

On consideration of appellant's motion for summary reversal, the opposition thereto, and of appellant's motion for reconsideration of this Court's order of May 22, 1974, it is

ORDERED by the Court that appellant's aforesaid motion for summary reversal is denied, and, it is

FURTHER ORDERED by the Court that the time for filing appellant's brief is extended for a period of 15 days from the date of this order.

Per Curiam

ORDER OF OCTOBER 18, 1974

BY THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Before: Bazelon, Chief Judge, Wright, McGowan, Tamm, Leventhal, Robinson, MacKinnon, Robb and Wilkey, Circuit Judges

On consideration of the petition for rehearing, *en banc*, of appellant's motion for summary reversal and no judge of the Court in regular active service having called for a vote thereon, it is

ORDERED by the Court, *en banc*, that appellant's aforesaid suggestion is denied.

Per Curiam

MEMORANDUM-ORDER

ENTERED JANUARY 10, 1974
BY THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

This matter came before the Court upon remand from the Court of Appeals to consider plaintiff's request for indices of manuscript decisions and to further examine matters relating to the original complaint.[1]

Originally, this Court entered an Order on October 26, 1970, granting defendant's motion to dismiss the complaint,[2] except insofar as this Court ordered the Patent Office to create and maintain an index of current unpublished manuscript decisions.[3] Plaintiff had requested "all unpublished manuscript decisions together with such indices as are available." This Court rejected that request as too broad to be "identifiable records" within the meaning of 5 U.S.C. § 552(a)(3), and, accordingly, denied the request. Because it appeared that plaintiff would be unable to formulate a request of the necessary specificity without some sort of index being available, the Order required the Patent Office to create and maintain a current index under 5 U.S.C. § 552(a)(2).

On appeal, plaintiff renewed his claim as to both the manuscript decisions and the indices. The Court of Ap-

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[1] "Construing the request for indices as separate from the request for all manuscript decisions, we think appellant is entitled to a remand for consideration and disposition of this part of the case . . . . We of course leave open the question whether the remand . . . might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion . . . ."

465 F.2d 608, 613-14 (D.C. Cir. 1972).

[2] 321 F. Supp. 628 (D.D.C. 1970).

[3] *Id.* at 629.

peals affirmed the dismissal of the complaint as to the request for all manuscript decisions,[4] but left open for reconsideration on remand the question of available indices and also the possibility that an amended complaint could be framed to make the records request acceptable.[5]

The Court held an oral hearing May 10, 1973, and received detailed memoranda from each side exploring the question of the available indices. In addition, plaintiff has sought to file an amended and a second amended complaint, and numerous other motions have been made.

I. The Indices.

The indices plaintiff seeks fall into three categories. The first involves a series of bound volumes collecting manuscript decisions from 1853 to 1954. There are 175 volumes in the series, in which manuscript decisions are chronologically arranged.[6] Bound into the front of volumes 1 through 144 is an alphabetical index consisting of 26 pages, one page for each letter of the alphabet.[7] On each page is listed the name in which the patent application was filed, and the page number at which the decision in that application appears. Because the volumes are of folio size and each consists of three to four hundred pages, and because most manuscript decisions are one page or less, each volume contains a large number of decisions.

If these indices were to be made available, the Patent Office would have to copy them via a photographic repro-

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[4] 465 F.2d 608, 613, 614 (D.C. Cir. 1972).

[5] *Id.* at 613-15.

[6] Affidavit of Raymond E. Martin, Associate Solicitor of the United States Patent Office at 2 (June 2, 1970).

[7] Information for this further description is based upon inspection of the Patent Office records warehouse November 30, 1973, by this Court's staff.

duction method. It is estimated that two man-days and an expenditure of $300 would be required to reproduce the approximately 3,744 pages in question.

The Court feels that these indices should be made available. Without the aid of some sort of index, plaintiff will forever be unable to formulate with specificity a request for manuscript decisions that would permit the Patent Office to produce the material desired. The current index being maintained by the Patent Office pursuant to the Court's Order of October 26, 1970, includes only decisions from July 4, 1967, forward.[8] This Court is clearly without authority to order the creation of an index for any material prior to that date,[9] but it is possible to order the reproduction of existing indices insofar as they are "identifiable records" that may be requested under 5 U.S.C. § 552(a)(3).

The Patent Office has raised some objections to the reproduction and release of these indices. In short, it contends that 35 U.S.C. § 122 (confidential status of patent applications) requires the Patent Office to refrain from giving out any information about patent applications. Because abandoned applications are considered to be covered by this section,[10] the Patent Office argues that to release an index to manuscript decisions bound in a volume containing decisions in both abandoned as well as granted patent applications is to violate 35 U.S.C. § 122, because giving out the name of the applicant (as listed in the index) is giving out "information." The Court finds this argument of insufficient merit to prevent the release of the indices.

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[8] 321 F. Supp. at 629.

[9] The Freedom of Information Act only provides for a current index. 5 U.S.C. § 552(a)(2). *See* Davis, Administrative Law Treatise, § 3A.14 (1970 Supp).

[10] *See* United States Department of Commerce, Patent Office, Rules of Practice 14(b) (January 1970).

35 U.S.C. § 122 states:

> Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

The Freedom of Information Act was designed to "establish a general philosophy of full agency disclosure unless information is exempted under clearly delineated statutory language . . . ."[11] The statutory language of 35 U.S.C. § 122 does not clearly delineate what "no information" means. It strains reason, however, to say the release of the name of an applicant is conclusively barred when Section 122 also states that "information" may be released if "necessary to carry out the provisions of any Act of Congress. . . . " 5 U.S.C. is such an Act.

Case law has recognized that Section 122 does not throw an impenetrable cloak of secrecy around all aspects of patent applications. Although in the context of patent interference litigation rather than a Freedom of Information Act case, courts have uniformly held that disclosure of confidential files must be made where justice requires.[12] Because Section 122 cannot be grounds for maintaining secrecy when it would be unreasonable to have such

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[11] S. Rep. No. 813, 89th Cong., 1st Sess. 3 (1965). "A democratic society requires an informed, intelligent electorate, and the intelligence of the electorate varies as the quantity and quality of its information varies." H. Rep. No. 1497, 89th Cong., 2d Sess. 12 (1966).

[12] *See, e.g., James B. Clow & Sons, Inc.* v. *United States Pipe and Foundry Co.*, 313 F.2d 46, 51 (5th Cir. 1963); *Struthers Scientific & Int'l Corp.* v. *General Foods Corp.*, 45 F.R.D. 375, 381 (S.D. Texas 1968); *Britt Tech. Corp.* v. *L. & A. Products, Inc.*, 223 F. Supp. 126 (D. Minn. 1963); *Cardex Corp.* v. *Olin Mathieson Chemical Corp.*, 23 F.R.D. 27, 31 (S.D. Ill. 1958); *Great Lakes Carbon Corp.* v. *Continental Oil Co.*, 23 F.R.D. 33 (W.D. La. 1958).

secrecy, it cannot bar the revelation of applicants' names in the indices in question.[13] Further, the most recent of the manuscript decisions involved is 1923. The intervening fifty years reduces significantly the possibility that any prejudice could result from the revelation of an applicant's name in this index.

The Patent Office further argues that the recent decision by Judge Oren Lewis in *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973, supports its position that the indices cannot be released under 35 U.S.C. § 122. The demand made in that case was for "all existing abandoned United States patent applications."[14] Judge Lewis held that abandoned applications, maintained in secrecy pursuant to Section 122 and Patent Office rules,[15] are exempted under 5 U.S.C. § 552(b)(3), the prior statute exemption.[16] This Court is in agreement with Judge Lewis' ruling, but feels it does not support the Patent Office's position insofar as these indices are concerned. There is a vast difference between a broad, sweeping request for the entire contents of all abandoned patent applications and the release of a 70-year compilation of indices containing only the bare name of the applicant.

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[13] Of course, the Patent Office may at its option review these indices with an eye toward blocking out the names of any and all applicants who have not been granted a patent. The Court recognizes, however, that a tremendous number of man-hours would be required to perform this task, and does not feel that such editing is necessary to comply with Section 122.

[14] *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. V. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973.

[15] See note 10, *supra*, and accompanying text.

[16] *Sears* v. *Gottschalk*, *supra*, at 1329-30.

II. Further indices.

Plaintiff claims that further indices exist and should be released. The claimed indices are "docket cards" and "file wrapper jackets." The former is a master card for recording each and every event in the course of processing a patent application; the latter serves a similar function, but is at the same time attached to the front of the applications file. Neither the cards nor the jackets are collected in any way that would serve a regular index function within the Patent Office, and they contain considerably more information about individual applications than do the indices discussed in Part I.

This sort of material is not a true index, and cannot be considered as such for the use of plaintiff. Further, because each contains considerably more information about the application, including an indication of the type of invention involved, these items fall into the group of materials protected by 35 U.S.C. § 122 and the rulings of *Misegades & Douglas* v. *Schuyler*, 328 F. Supp. 619 (E.D. Va. 1971), and *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973). Accordingly, docket cards and file wrapper jackets will not be made available to plaintiff as an index.

III. Amended Complaint.

Plaintiff has submitted motions for leave to file an amended, and later, a second amended complaint. That latter proposed complaint evidently represents a further adjustment of the complaint to conform with the facts of the case and with the spirit of the Court of Appeals' recommendation that further consideration in this Court may lead to "the possibility of such amendment of the complaint as the District Court may permit in the exercise of a sound discretion. . . ." 465 F.2d 608, 614 (D.C. Cir. 1972).

Where a motion to dismiss the complaint has been granted and sustained, as is the case here, the trial court has discretion to permit amendment of the complaint only where the order of the Court of Appeals specifically provides for such action.[17] Because that is the case here, this Court must consider whether or not the amended complaint will cure the defects of the original one.[18] In this case, it must be said that it will not. Additional relief is already being granted to the extent that certain existing indices will be made available. As to the remainder of additional relief demanded by plaintiff, the Court, in the exercise of its discretion, denies leave to file either the amended or second amended complaint. Even so, virtually every form of relief requested by plaintiff in the second amended complaint is before the Court in the form of separate motions. For instance, on June 19, 1973, plaintiff moved for partial summary judgment under Fed. R. Civ. P. 56 and 54(c), seeking an order requiring the Patent Office to produce (1) the "170 to 175 volumes" of manuscript decisions covering the years 1853-1954, and (2) any and all indices that may exist in the files of the Patent Office, including the indices to the bound volumes, the individual docket cards, and the file wrapper jacket. The only additional items sought by the proposed second amended complaint are (1) all manuscript decisions from 1955 to the present and any unbound decisions prior to 1955, (2) an order forbidding the Patent Office from continuing its periodic destruction of old abandoned patent applications, and (3) an order requiring the Patent Office to comply fully with this Court's Order of October 26, 1970.

The first of these three issues, the demand for all manuscript decisions not included in the 175 bound

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[17] *Ginsberg* v. *Stern*, 242 F.2d 379 (3rd Cir. 1957); *United States* v. *Newberry Mfg. Co.*, 123 F.2d 453 (1st Cir. 1941).

[18] *See Kirsch* v. *Barnes*, 157 F. Supp. 671 (N.D. Cal. 1957).

volumes, is clearly the same type of broad, sweeping and indiscriminate request originally denied by this Court October 26, 1970, and sustained by the Court of Appeals June 15, 1972. No such amendment will be allowed.

The second and third of these three issues raised in the proposed second amended complaint that are not found in the motion for partial summary judgment are before this Court by way of separate motions submitted by the plaintiff. Specifically, on June 11, 1973, plaintiff moved for a "rule to show cause why defendant should not be held in contempt for willful obstruction of justice," referring to the destruction of certain docket cards. Because docket cards have already been considered and rejected as an "available index" pursuant to the remand from the Court of Appeals,[19] this motion will be denied, and the Patent Office may continue routine destruction of agency records.[20] Also, on June 11, plaintiff moved this Court for a "rule to show cause pursuant to 5 U.S.C. § 552(a)(3) and Fed. R. Civ. P. 70 why defendant should not be held in contempt for failure to comply with October 26, 1970 Order." This motion will be considered below.[21]

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[19] *See* Part II.

[20] The proposed second amended complaint also complains of the destruction of manuscript decisions. It is evidently the policy of the Patent Office to consider abandoned applications eligible for destruction after twenty years, and presumably manuscript decisions contained therein would also be destroyed. *See* United States Department of Commerce, Patent Office, Rules of Practice 14(b) (January 1970). Because plaintiff's broad request for all manuscript decisions was denied by the Court, affirmed on appeal, it would not be appropriate to consider such routine agency destruction of old manuscript decisions. However, any manuscript decisions contained in the bound volumes 1-144 to which an index will be made available, and any manuscript decisions indexed under this Court's Order of October 26, 1970, may not be destroyed.

[21] See Part V, *infra*.

Thus it is apparent that despite denying leave to file an amended complaint, the Court is giving consideration to every issue reasonably raised therein through consideration of the two motions of June 11, 1973, and the motion for partial summary judgment of June 19, 1973.

IV. Summary Judgment.

As previously noted, on June 19, 1973, plaintiff moved the Court for partial summary judgment, seeking the 175 bound volumes of manuscript decisions compiled from 1853 to 1954, and any and all indices to manuscript decisions. The latter portion of the request has already been dealt with extensively pursuant to the Court of Appeals' remand and will not be repeated here.[22]

Asking for 175 bound folio volumes of manuscript decisions does somewhat narrow plaintiff's original request, but still lacks requisite specificity. Each volume contains hundreds of decisions, thus making the compilation one of about 100,000 decisions. The question of whether or not this is a request for "identifiable records" within the meaning of *Bristol-Myers Co.* v. *F.T.C.*, 424 F.2d 935 (D.C. Cir. 1970), and *American Mail Line, Ltd.* v. *Gulick*, 411 F.2d 696 (D.C. Cir. 1969), need not be decided here, however, for another consideration takes precedence. Because a manuscript decision in a patent application is protected as being a portion of that file,[23] release of the bound volume *in toto* would mean release of manuscript decisions in pending and abandoned applications as well as granted ones—and the former have a confidential status that is protected by Section 122.[24]

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[22] See Parts I and II, *supra*.

[23] *Cf. Misegades & Douglas* v. *Schuyler*, 328 F. Supp. 619 (E.D. Va. 1971), *appeal dismissed* 456 F.2d 255 (4th Cir. 1972).

[24] The Court recognizes that very few of the manuscript decisions in question would be in still-pending applications, but is also mindful that abandoned applications have been held to enjoy that same

By ordering the release of the indices to all those volumes which are presently indexed, i.e., volumes 1-144, the Court is making available to plaintiff a means for formulating a more specific request. If a requested manuscript decision is available to the public, the Patent Office will be able to produce the volume containing that decision and thereby make the decision available.[25] If a requested decision is not available because the application was never granted, the Patent Office will so inform the one making the request. In this way plaintiff and all others will be assured a means of access to all those bound decisions from 1853 to 1923 which can be made available under Section 122. Accordingly, that portion of plaintiff's motion for summary judgment which requests all 175 bound volumes will be denied.

V. Contempt Motion

Plaintiff moves to hold defendant in contempt of Court for failure to fully comply with the October 26, 1970, Order requiring that

> the United States Patent Office maintain and make available for public inspection and copying a current index providing identifying information for the public as to the unpublished manuscript decisions of the Patent Office since July 4, 1967, insofar as the same is required by 5 U.S.C. § 552(a)(2).

321 F. Supp. at 629.

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secrecy. *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973.

[25] The Patent Office has objected to this procedure on the grounds that if it must produce a volume containing a requested decision, the person requesting the decision would then be able to see decisions in that same volume held in confidentiality under Section 122. The Court feels that by either reproducing and making available a copy of the requested decision or by monitoring the requester as he reads and/or copies the requested decision, any such feared breach of confidentiality can easily be avoided. There is little likelihood that the volume of requests would be such as to seriously inconvenience the Patent Office.

Plaintiff makes no allegation that the Patent Office is not satisfactorily indexing its manuscript decisions, but rather raises questions as to material referred to in 5 U.S.C. § 552(a)(2)(B) and (C), that is, statements of policy not published in the Federal Register, staff manuals and instructions to staff affecting the public. The Court notes that these items were never requested in plaintiff's original complaint, and as a result, they were not incorporated into the Order of October 26, 1970. Because that Order has been affirmed and this case is on remand for limited purposes only, the issue of whether or not the Patent Office is fully indexing Section 552 (a)(2)(B) and (C) material is not properly before the Court.

Upon inspection of the indices being maintained, the Court finds full compliance with the October 1970 Order. The Patent Office has compiled five indices which comprehensively cover Board of Appeals decisions, Board of Patent Interference decisions, and Commissioner's decisions. For the first group, two indices are maintained: one consists of decisions in granted applications, i.e., those generally available to the public. This index lists the patent application number, and classifies the decisions into 36 categories, with cross-references to other applicable categories. Determining the nature of the categories is a simple exercise. The second Board of Appeals index is one compiling all other decisions under coded appeals numbers, and thus indexes both unavailable decisions (pending, denied or abandoned applications) and very recently available decisions (those which have matured into patents after the entry of the decisions indexed and before the next updating of the "public" index). This latter index is also available to the public, and upon request the Patent Office will research the file of a particular application to see whether or not it can be

publicly released. The two indices are both updated quarterly.

Board Of Patent Interference decisions are treated in two indices, in a like fashion to Board of Appeals decisions, but one not updated on a regular basis.[26] These indices of decisions are also classified in 36 categories, but are not cross-referenced in the manner of the Board of Appeals decisions. Both are available to the public on the same terms as the Board of Appeals indices.

Commissioner's decisions have been one index, covering both available and protected decisions, compiled by a system of code numbers. Due to their particular scope and function,[27] very few of these decisions would ever be available to the public. Therefore, when a request for one is made, the Patent Office will research its files to see if release would be permissible. The Court has also gone on to investigate 5 U.S.C. § 552(a)(2)(B) and (C) material, and found that there are apparently no statements of policy, staff manuals or staff instructions that are not already available to the public. Accordingly, the Court overrules this motion.

VI. Conclusion

The Court has carefully considered all matters brought to its attention by both the remand from the Court of Appeals and the various motions and memoranda filed by the parties, and accordingly, it is by the Court this 10th day of January, 1974,

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[26] There are many fewer such decisions, and quarterly up-dating is highly wasteful in terms of computer operation time; accordingly, the Patent Office has no regular schedule for up-dating these indices, but anticipates roughly annual review.

[27] United States Department of Commerce, Patent Office, Rules of Practice 113 and 181 (January 1970).

ORDERED that each index bound in the front of volumes 1-144 be reproduced and made available in order to aid plaintiff in formulating more specific requests for identifiable records under 5 U.S.C. § 552(a)(3); and it is further

ORDERED that plaintiff's motion for partial summary judgment be granted only insofar as the indices of bound volumes 1-144 are concerned; and it is further

ORDERED that the remaining portions of plaintiff's motion for partial summary judgment be denied; and it is further

ORDERED that plaintiff's motion for leave to file a second amended complaint be denied; and it is further

ORDERED that plaintiff's contempt motion as regards routine destruction of agency records be denied; and it is further

ORDERED that plaintiff's contempt motion for failure to comply with this Court's Order of October 26, 1970, be denied; and it is further

ORDERED that plaintiff's motion to reconsider granting defendants' motion to quash subpoena on Raymond Martin (Order of May 7, 1973) be denied as moot.

/s/ Oliver Gasch, Judge

MEMORANDUM ORDER

ENTERED MARCH 11, 1974
BY THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA

This matter comes before the Court upon plaintiff's motion to vacate the Court's Memorandum-Order of January 10, 1974, to recuse the district judge and to reopen proceedings. Only the second of these points, the requested recusal, necessitates consideration.

This action was filed under the Freedom of Information Act against the Commissioner of Patents in 1970, seeking access to all past manuscript decisions of the Patent Office. On October 26, 1970, this Court granted defendant's motion to dismiss for lack of a sufficiently specific request, except insofar as the defendant was ordered to maintain a current index of manuscript decisions to aid plaintiff in formulating more specific requests. Plaintiff appealed. The United States Court of Appeals sustained the dismissal, but remanded for exploration of existing indices that would aid plaintiff in stating a request; the Court of Appeals also indicated that such exploration "might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion . . . . 151 U.S.App.D.C. 23 ,29, 465 F.2d 608, 614.

After a hearing and after consideration of lengthy memoranda submitted by both parties, this Court issued the Memorandum-Order in question, which denied leave for plaintiff to file his second amended complaint on the grounds that the proposed complaint was still lacking in the necessary specificity under 5 U.S.C. § 552 (a)(3). However, the Court dealt with virtually every

issue raised in the proposed complaint through consideration of several additional motions filed by plaintiff. Some further relief was granted, that is, the release of certain existing indices which may aid plaintiff in formulating requests of the necessary specificity.

In considering the many questions raised by plaintiff upon remand, the Court deemed it advisable to gain a better perspective on the materials actually in issue. To this end, a member of this Court's staff viewed the Patent Office warehouse November 30, 1973, to see exactly what bound volumes of manuscript decisions were in existence and to examine the indices attached thereto. At the same time, the Court also sought to ascertain the nature of the indices being maintained by the Patent Office under the Memorandum-Order of October 26, 1970. This effort by the Court to more accurately ascertain what lay at the root of this action was not hidden from the plaintiff, as it was fully acknowledged in the Memorandum-Order of January 10, 1974, footnote 7.

The conduct of the Court in all litigation should be focused on securing "the just, speedy, and inexpensive determination of every action." Fed. R. Civ. P. 1. It was to this end that a physical inspection of the manuscript decisions and indices was made. An *in camera* inspection would have required the transfer of numerous bulky and heavy items to the Court House, clearly a burden on both the Patent Office and this Court. The method chosen was to send a member of this Court's staff to the Patent Office to report on the physical existence and makeup of these items. Both judicial economy and economy of the parties was served.

Plaintiff has made many varied allegations in support of the motion for recusal. First, plaintiff assumes that at least two separate visits were made; in fact, the only visit was that of November 30, 1973, fully identified by the Court in the Memorandum-Order. Further,

plaintiff objects to the characterization of the bound volumes inspected as being a "compilation . . . of about 100,000 decisions" as not having previously appeared in the record. It is a simple exercise to note the average length of manuscript decisions and the number of pages in an average volume in order to reach the conclusion that 175 volumes contain approximately that number of decisions. Plaintiff himself indicated in open Court that the number of unpublished manuscript decisions is "[m]any thousands I am quite sure." The Court can see no prejudice in this finding.

Plaintiff objects to the Court's characterization that "[i]t is estimated that two man-days and an expenditure of $300 would be required to reproduce the approximately 3,744 pages in question." It is difficult to understand plaintiff's objection to this finding, inasmuch as the Court ordered those indices reproduced. Nor does it indicate a damaging *ex parte* presentation of the Patent Office, as it is a simple exercise for anyone vaguely familiar with photocopy techniques to make a rough estimate of the time and expense involved in the reproduction of 3,744 folio pages.

Plaintiff has also pointed to the Court's staff inspection of the indices being maintained by the Patent Office pursuant to the Memorandum-Order of October 26, 1970, as further evidence of *ex parte* conduct. It should be noted that in the Order of January 10, 1974, the Court found that "[p]laintiff makes no allegation that the Patent Office is not satisfactorily indexing its manuscript decisions . . . ," and that the contempt motion under consideration was "not properly before the Court." However, because this litigation has centered around the need for indices from which plaintiff and other members of the public could make a request of the necessary specificity of the Patent Office, the Court deemed it wise to inspect the indices, which are available to the public, to asertain whether there has been full compliance with

this Court's Order of October 26, 1970. This inspection, like that of the records warehouse, was a physical identification of material.

Plaintiff also would appear to be accusing the United States Attorney of filing a false sworn answer to his interrogatory no. 14. That highly unusual interrogatory read:

> Has defendant or any one acting on defendants' behalf, including a member of the U.S. Attorney's staff, been in contact with anyone from Judge Gasch's office or staff, including Judge Gasch, in regard to any aspect of this case, including the timing of future proceedings herein at any time since May 10, 1973?
>
> If the answer to this interrogatory is anything other than an unqualified no, (a) Describe fully each contact including without limitation as a part of the answer the names and addresses of all persons involved, the date, time and circumstances of the meeting including how it came about, the substance of what was said by each involved person and an identification of any and all pertinent documents that may exist.

Michael J. Ryan, Assistant United States Attorney, answered November 15, 1973:

> Interrogatory 14 is highly objectionable as being irrelevant, improper and scandalous, in that it impugns the integrity of both the Court and counsel. The answer, however, is an unequivocal no.

Plaintiff accuses the United States Attorney of a false answer by assuming that an inspection by the Court's staff November 30, 1973, meant that there must have been some contact prior to November 15, 1973. In fact, plaintiff's assumption is wrong, and the answer of the United States Attorney was not, as plaintiff claims, a false one.

Plaintiff objects to this Court's characterization of docket cards and file wrapper jackets as not being meaningful indices, claiming that no support for the Court's finding is in the record. That is not the case. Information supporting this finding can be found in defendant's Memorandum After Oral Hearing on Plaintiff's Motion for Leave to File Amended Complaint at 3-13.

Plaintiff relies on the case *In Re Murchison*, 349 U.S. 133 (1955), wherein the Supreme Court found that a judge who had conducted a secret "one man grand jury" in a contempt proceeding could not preside at the ensuing trial of the same matter. The Court's action in making a staff inspection of the manuscript decisions and the indices being maintained pursuant to this Court's prior Order is vastly different. This litigation has been long and difficult. Many motions have been considered, it has been heard by the Court of Appeals and again by this Court on remand. An extensive record exists. The Court, in its effort to reach a just and expeditious conclusion to the matter, made a physical inspection of certain items to assure that the relief granted January 10, 1974, (release of the indices to bound manuscript decisions) was both physically possible and meaningful to plaintiff. The Court finds no element of prejudice to the plaintiff in the action of November 30, 1973.

Accordingly, it is by the Court this 11th day of March, 1974,

ORDERED that plaintiff's motion to vacate the Memorandum-Order of January 10, 1974, to recuse and to reopen proceedings be and the same is hereby denied.

/s/ Oliver Gasch
Judge

CODE OF JUDICIAL CONDUCT

CANON 2

A Judge Should Avoid Impropriety and the Appearance of Impropriety in All His Activities

A. A judge should respect and comply with the law and should conduct himself at all times in a manner that promotes public confidence in the integrity and impartiality of the judiciary.

B. A judge should not allow his family, social, or other relationships to influence his judicial conduct or judgment. He should not lend the prestige of his office to advance the private interests of others; nor should he convey or permit others to convey the impression that they are in a special position to influence him. He should not testify voluntarily as a character witness.

Commentary: Public confidence in the judiciary is eroded by irresponsible or improper conduct by judges. A judge must avoid all impropriety and appearance of impropriety. He must expect to be the subject of constant public scrutiny. He must therefore accept restrictions on his conduct that might be viewed as burdensome by the ordinary citizen and should do so freely and willingly.

The testimony of a judge as a character witness injects the prestige of his office into the proceeding in which he testifies and may be misunderstood to be an official testimonial. This Canon, however, does not afford him a privilege against testifying in response to an official summons.

CANON 3

A Judge Should Perform the Duties of His Office Impartially and Diligently

The judicial duties of a judge take precedence over all his other activities. His judicial duties include all the duties of his office prescribed by law. In the performance of these duties, the following standards apply:

A. ADJUDICATIVE RESPONSIBILITIES.

(1) A judge should be faithful to the law and maintain professional competence in it. He should be unswayed by partisan interests, public clamor, or fear of criticism.

(2) A judge should maintain order and decorum in proceedings before him.

(3) A judge should be patient, dignified, and courteous to litigants, jurors, witnesses, lawyers, and others with whom he deals in his official capacity, and should require similar conduct of lawyers, and of his staff, court officials, and others subject to his direction and control.

Commentary: The duty to hear all proceedings fairly and with patience is not inconsistent with the duty to dispose promptly of the business of the court. Courts can be efficient and business-like while being patient and deliberate.

(4) A judge should accord to every person who is legally interested in a proceeding, or his lawyer, full right to be heard according to law, and, except as authorized by law, neither initiate nor consider *ex parte* or other communications concerning a pending or impending proceeding. A judge, however, may obtain the advice of a disinterested expert on the law applicable to a proceed-

ing before him if he gives notice to the parties of the person consulted and the substance of the advice, and affords the parties reasonable opportunity to respond.

Commentary: The proscription against communications concerning a proceeding includes communications from lawyers, law teachers, and other persons who are not participants in the proceeding, except to the limited extent permitted. It does not preclude a judge from consulting with other judges, or with court personnel whose function is to aid the judge in carrying out his adjudicative responsibilities.

An appropriate and often desirable procedure for a court to obtain the advice of a disinterested expert on legal issues is to invite him to file a brief *amicus curiae.*

(5) A judge should dispose promptly of the business of the court.

Commentary: Prompt disposition of the court's business requires a judge to devote adequate time to his duties, to be punctual in attending court and expeditious in determining matters under submission, and to insist that court officials, litigants and their lawyers cooperate with him to that end.

(6) A judge should abstain from public comment about a pending or impending proceeding in any court, and should require similar abstention on the part of court personnel subject to his direction and control. This subsection does not prohibit judges from making public statements in the course of their official duties or from explaining for public information the procedures of the court.

Commentary: "Court personnel" does not include the lawyers in a proceeding before a judge. The conduct of lawyers is governed by DR7-107 of the *Code of Professional Responsibility.*

(7) A judge should prohibit broadcasting, televising, recording, or taking photographs in the courtroom and areas immediately adjacent thereto during sessions of court or recesses between sessions, except that a judge may authorize:

(a) the use of electronic or photographic means for the presentation of evidence, for the perpetuation of a record, or for other purposes of judicial administration;

(b) the broadcasting, televising, recording, or photographing of investitive, ceremonial, or naturalization proceedings;

(c) the photographic or electronic recordings and reproduction of appropriate court proceedings under the following conditions:

(i) the means of recording will not distract participants or impair the dignity of the proceedings;

(ii) the parties have consented, and the consent to being depicted or recorded has been obtained from each witness appearing in the recording and reproduction;

(iii) the reproduction will not be exhibited until after the proceeding has been concluded and all direct appeals have been exhausted; and

(iv) the reproduction will be exhibited only for instructional purposes in educational institutions.

Commentary: Temperate conduct of judicial proceedings is essential to the fair administration of justice. The recording and reproduction of a proceeding should not distor or dramatize the proceeding.

B. ADMINISTRATIVE RESPONSIBILITIES

(1) A judge should diligently discharge his administrative responsibilities, maintain professional competence

in judicial administration, and facilitate the performance of the administrative responsibilities of other judges and court officials.

(2) A judge should require his staff and court officials subject to his direction and control to observe the standdards of fidelity and diligence that apply to him.

(3) A judge should take or initiate appropriate disciplinary measures against a judge or lawyer for unproffessional conduct of which the judge may become aware.

Commentary: Disciplinary measures may include reporting a lawyer's misconduct to an appropriate disciplinary body.

(4) A judge should not make unnecessary appointments. He should exercise his power of appointment only on the basis of merit, avoiding nepotism and favoritism. He should not approve compensation of appointees beyond the fair value of services rendered.

Commentary: Appointees of the judge include officials such as referees, commissioners, special masters, receivers, guardians and personnel such as clerks, secretaries, and bailiff. Consent by the parties to an appointment or an award of compensation does not relieve the judge of the obligation prescribed by this subsection.

C. DISQUALIFICATION.

(1) A judge should disqualify himself in a proceeding in which his impartiality might reasonably be questioned, including but not limited to instances where:

(a) he has a personal bias or prejudice concerning a party, or personal knowledge of disputed evidentiary facts concerning the proceeding;

(b) he served as lawyer in the matter in controversy, or a lawyer with whom he previously practiced law

served during such association as a lawyer concerning the matter, or the judge or such lawyer has been a material witness concerning it;

Commentary: A lawyer in a governmental agency does not necessarily have an association with other lawyers employed by that agency within the meaning of this subsection; a judge formerly employed by a governmental agency, however, should disqualify himself in a proceeding if his impartiality might reasonably be questioned because of such association.

(c) he knows that he, individually or as a fiduciary, or his spouse or minor child residing in his household, has a financial interest in the subject matter in controversy or in a party to the proceeding, or any other interest that could be substantially affected by the outcome of the proceeding;

(d) he or his spouse, or a person within the third degree of relationship to either of them, or the spouse of such a person:

(i) is a party to the proceeding, or an officer, director, or trustee of a party;

(ii) is acting as a lawyer in the proceeding;

Commentary: The fact that a lawyer in a proceeding is affiliated with a law firm with which a lawyer-relative of the judge is affiliated does not of itself disqualify the judge. Under appropriate circumstances, the fact that "his impartiality might reasonably be questioned" under Canon 3(C)(1), or that the lawyer-relative is known by the judge to have an interest in the law firm that could be "substantially affected by the outcome of the proceeding" under Canon 3(C)(1)(d)(iii) may require his disqualification.

(iii) is known by the judge to have an interest that could be substantially affected by the outcome of the proceeding;

(iv) is to the judge's knowledge likely to be a material witness in the proceeding;

(2) A judge should inform himself about his personal and fiduciary financial interests, and make a reasonable effort to inform himself about the personal financial interests of his spouse and minor children residing in his household.

(3) For the purposes of this section:

(a) the degree of relationship is calculated according to the civil law system;

Commentary: According to the civil law system, the third degree of relationship test would, for example, disqualify the judge if his or his spouse's father, grandfather, uncle, brother, or niece's husband were a party or lawyer in the proceeding, but would not disqualify him if a cousin were a party or lawyer in the proceeding.

(b) "fiduciary" includes such relationships as executor, administrator, trustee, and guardian;

(c) "financial interest" means ownership of a legal or equitable interest, however small, or a relationship as director, advisor, or other active participant in the affairs of a party, except that:

(i) ownership in a mutual or common investment fund that holds securities is not a "financial interest" in such securities unless the judge participates in the management of the fund;

(ii) an office in an educational, religious, charitable, fraternal, or civic organization is not a "financial interest" in securities held by the organization;

(iii) the proprietary interest of a policy holder in a mutual insurance company, of a depositor in a mutual savings association, or a similar proprietary interest, is a "financial interest" in the organization only if the out-

come of the proceeding could substantially affect the value of the interest;

(iv) ownership of government securities is a "financial interest" in the issuer only if the outcome of the proceeding could substantially affect the value of the securities.

D. REMITTAL OF DISQUALIFICATION.

A judge disqualified by the terms of Canon 3C(1)(c) or Canon 3C(1)(d) may, instead of withdrawing from the proceeding, disclose on the record the basis of his disqualification. If, based on such disclosure, the parties and lawyers, independently of the judge's participation all agree in writing that the judge's relationship is immaterial or that his financial interest is insubstantial, the judge is no longer disqualified, and may participate in the proceeding. The agreement, signed by all parties and lawyers, shall be incorporated in the record of the proceeding.

Commentary: This procedure is designed to minimize the chance that a party or lawyer will feel coerced into an agreement. When a party is not immediately available, the judge without violating this section may proceed on the written assurance of the lawyer that his party's consent will be subsequently filed.

5 U.S.C. 552

§ 552. Public information; agency rules, opinions, orders, records, and proceedings

(a) Each agency shall make available to the public information as follows:

(1) Each agency shall separately state and currently publish in the Federal Register for the guidance of the public—

(A) descriptions of its central and field organization and the established places at which, the employees (and in the case of a uniformed service, the members) from whom, and the methods whereby, the public may obtain information, make submittals or requests, or obtain decisions;

(B) statements of the general course and method by which its functions are channeled and determined, including the nature and requirements of all formal and informal procedures available;

(C) rules of procedure, descriptions of forms available or the places at which forms may be obtained, and instructions as to the scope and contents of all papers, reports, or examinations;

(D) substantive rules of general applicability adopted as authorized by law, and statements of general policy or interpretations of general applicability formulated and adopted by the agency; and

(E) each amendment, revision, or repeal of the foregoing.

Except to the extent that a person has actual and timely notice of the terms thereof, a person may not in any manner be required to resort to, or be adversely affected by, a matter required to be published in the Federal Register and not so published. For the purpose of this paragraph, matter reasonably available to the class of

persons affected thereby is deemed published in the Federal Register when incorporated by reference therein with the approval of the Director of the Federal Register.

(2) Each agency, in accordance with published rules, shall make available for public inspection and copying—

(A) final opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases;

(B) those statements of policy and interpretations which have been adopted by the agency and are not published in the Federal Register; and

(C) administrative staff manuals and instructions to staff that affect a member of the public;

unless the materials are promptly published and copies offered for sale. To the extent required to prevent a clearly unwarranted invasion of personal privacy, an agency may delete identifying details when it makes available or publishes an opinion, statement of policy, interpretation, or staff manual or instruction. However, in each case the justification for the deletion shall be explained fully in writing. Each agency also shall maintain and make available for public inspection and copying a current index providing identifying information for the public as to any matter issued, adopted, or promulgated after July 4, 1967, and required by this paragraph to be made available or published. A final order, opinion, statement of policy, interpretation, or staff manual or instruction that affects a member of the public may be relied on, used, or cited as precedent by an agency against a party other than an agency only if—

(i) it has been indexed and either made available or published as provided by this paragraph; or

(ii) the party has actual and timely notice of the terms thereof.

(3) Except with respect to the records made available under paragraphs (1) and (2) of this subsection, each agency, on request for identifiable records made in accordance with published rules stating the time, place, fees to the extent authorized by statute, and procedure to be followed, shall make the records promptly available to any person. On complaint, the district court of the United States in the district in which the complainant resides, or has his principal place of business, or in which the agency records are situated, has jurisdiction to enjoin the agency from withholding agency records and to order the production of any agency records improperly withheld from the complainant. In such a case the court shall determine the matter de novo and the burden is on the agency to sustain its action. In the event of noncompliance with the order of the court, the district court may punish for contempt the responsible employee, and in the case of a uniformed service, the responsible member. Except as to causes the court considers of greater importance, proceedings before the district court, as authorized by this paragraph, take precedence on the docket over all other causes and shall be assigned for hearing and trial at the earliest practicable date and expedited in every way.

(4) Each agency having more than one member shall maintain and make available for public inspection a record of the final votes of each member in every agency proceeding.

(b) This section does not apply to matters that are—

(1) specifically required by Executive order to be kept secret in the interest of the national defense or foreign policy;

(2) related solely to the internal personnel rules and practices of an agency;

(3) specifically exempted from disclosure by statute;

(4) trade secrets and commercial or financial information obtained from a person and privileged or confidential;

(5) inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency;

(6) personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy;

(7) investigatory files compiled for law enforcement purposes except to the extent available by law to a party other than an agency;

(8) contained in or related to examination, operating, or condition reports prepared by, on behalf of, or for the use of an agency responsible for the regulation or supervision of financial institutions; or

(9) geological and geophysical information and data, including maps, concerning wells.

(c) This section does not authorize withholding of information or limit the availability of records to the public, except as specifically stated in this section. This section is not authority to withhold information from Congress.

PLAINTIFF'S STATEMENT OF MATERIAL FACTS AS TO WHICH THERE IS NO GENUINE ISSUE PURSUANT TO LOCAL RULE 9(h)

FILED JUNE 19, 1973

1. This action arises under 5 U.S.C. 552. Jurisdiction and venue are properly laid in this Court.

2. Defendant controls some 170 to 175 bound volumes of decisions within the scope of the decisions defined by 5 U.S.C. 552(a)(2)(A), (B) and (C) composed during the years 1853 to 1954, at least some of which include individual indices in the front of each volume.

3. These bound volumes of manuscript decisions constitute a class or category of documents identified as such by defendant and the Patent Office over which he is chief administrator, as shown *inter alia* by the June 15, 1972 decision of the Court of Appeals for the District of Columbia in this case.

4. Defendant also controls a number of docket cards of the Patent Office Board of Appeals, the Patent Office Board of Patent Interferences, and for individual patent applications whether pending, abandoned, or "allowed". These docket cards contain a full record of the proceedings in each appeal, interference, or application to which they pertain, including a record of each decision falling within the scope of 5 U.S.C. 552(a)(2)(A), (B), or (C), if any, rendered in connection with that appeal, interference, or application. It is therefore possible to determine from the docket cards the identity of each decision within the scope of 5 U.S.C. 552(a)(2)(A), (B) or (C) that may be contained in the associated appeal, interference, or application file.

5. Each presently existing patent application is maintained in the Patent Office in one or more file wrapper jackets. Each file wrapper jacket lists in date order

each of the papers contained in the file including each and every decision responding to the definitions contained in 5 U.S.C. 552(a)(2)(A), (B), or (C) if any, that may be contained in that application file. It is accordingly possible to determine from the file wrapper jacket index listing the identity of each decision within the scope of 552(a)(2)(A), (B), or (C) that may be contained in that application file.

6. The docket index cards have been previously identified by defendant as a group.

7. Defendant has also acknowledged that the outer jacket of the file of each application carries the same chronology of events as is entered on the docket cards and has thereby identified the file wrapper jacket index lists as a category of documents existent within the Patent Office.

In the Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-620

EDWARD S. IRONS, PETITIONER

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

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1. Petitioner seeks a writ of certiorari to review the court of appeals' denial of a motion for summary reversal and denial of a petition for rehearing *en banc* on that issue. The merits of the appeal are still pending before the court of appeals, although briefs have not yet been filed.

In this suit under the Freedom of Information Act, 5 U.S.C. 552, petitioner seeks access to all unpublished manuscript decisions of the Patent Office together with such indices as are available. The district court dismissed the request for manuscript decisions on the ground that it was "not a reasonable request for identifiable records, but rather a broad, sweeping, indiscriminate request for production lacking any specificity," and ordered the Patent Office to prepare a public index of post-July 1967 manuscript decisions. 321 F. Supp. 628. On appeal, the court of appeals affirmed the dismissal of the request for all un-

published manuscript decisions, but remanded for consideration of whether certain pre-existing indices could be disclosed to petitioner; and whether the complaint could be amended to make an acceptable request for the records sought.

On remand, the district court ordered the Patent Office to disclose indices, consisting of the name in which the patent application was filed and the page number, contained in 144 bound volumes of manuscript decisions, but refused petitioner's request for "docket cards" and "file wrapper jackets," on the grounds that the documents are not an index and are exempt from disclosure under 35 U.S.C. 122. The court refused to allow the complaint to be amended, on the grounds that the proposed amendments would not cure the defects of the original complaint and that the new matters raised in the proposed amendments were then before the court on various motions.

Petitioner moved to vacate the order and recuse the judge on the ground that the order revealed that the district judge had engaged in *ex parte* contacts with the respondent's representatives concerning controverted matters. The district court denied the motion, acknowledging contacts between a member of the judge's staff and the Patent Office, but denying that plaintiff had been prejudiced thereby.

Petitioner appealed to the court of appeals and asked for a summary reversal of the district court's order. The court of appeals, *per curiam,* denied petitioner's motion for summary reversal, and denied a petition for rehearing *en banc.*

The appeal on the merits is presently pending before the court of appeals, although briefs have not yet been filed.

2. No issue warranting further review is presented at this time.

The conduct of the district judge was in no way improper. As Judge Gasch pointed out in his order denying petitioner's motion to vacate the judgment, his actions in sending a member of his staff to inspect the indices involved in this case amounted merely to a "physical identification of material" (Pet. App. 19a).

3. Even if the conduct of the district judge had been improper, summary reversal is not warranted. Petitioner was not prejudiced by the court's physical identification of material. Any facts which allegedly were determined as a result of this determination were fully supported by the record in this case, or were undisputed and available, upon request, to any member of the public, or were found in petitioner's favor.

Nor did the other alleged improprieties deny petitioner a fair hearing. The district judge was acting entirely within his discretion in refusing to allow respondent's counsel, Mr. Martin, to be deposed.[1]

The question of alleged deficiencies in the index prepared by the Patent Office was fully presented to the district court, which held that petitioner must make a formal request to the Patent Office for those portions of the index in contention before the court would consider the question of noncompliance with *its own* order (see C.A. App. 80). The court clearly stated that if petitioner were not satisfied with the Patent Office's response, he could come back to the district court for relief. Moreover, in the memorandum-order of January 10, 1974, the court in effect held that non-final manuscript opinions do not fall within the categories of 5 U.S.C. 552(a)(2)(B) and (C), and, thus, were not required to be indexed under the order of October 26, 1970.

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[1]The facts regarding the matters in Mr. Martin's affidavit were known by other Patent Office officials, yet petitioner made no effort to depose anyone other than Mr. Martin.

Finally, respondent's failure to counter petitioner's "statement of material facts as to which there is no genuine issue" is immaterial. This litigation is over four years old. The issues, including the availability of the 175 bound volumes, have been hotly contested throughout the litigation, and it would have been exalting form above substance to accept that statement of facts as dispositive on the record as it stood.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

JANUARY 1975.

SUPREME COURT, U. S.

FILED

FEB 3 1975

MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-620

EDWARD S. IRONS,
Petitioner,

v.

COMMISSIONER OF PATENTS,
Respondent.

REPLY MEMORANDUM IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-620

EDWARD S. IRONS,

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COMMISSIONER OF PATENTS,

Respondent.

REPLY MEMORANDUM IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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1. Respondent's tardy memorandum in opposition[1] does not gainsay the importance of the questions pre-

[1] The petition was filed November 20, 1974. Respondent's brief was due, pursuant to the special treatment which Rule 24(1) affords the government, within fifty days plus the three days allowed for mail service—or by January 13, 1975 at the latest. With characteristic disregard for both tis opponent's rights and the Court's rules, respondent sought no extension of time but simply arrogated the privilege of filing a memorandum some eighteen (18) days later on January 31, 1975. The deliberate character of this transgression is manifest from respondent's effort at camouflage whereby in further derogation of the Court's rules, respondent's brief is dated simply "January, 1975" (R. Br. 4) rather than January *31*, 1975 as it should have been.

[Footnote continued on page 2]

sented or deny that they are properly raised in this case, but opposes the grant of certiorari as premature (point 1, R. Br. 2) and argues that the district court in any event had discretion to depart from accepted standards of judicial conduct and to deprive petitioner of a fair hearing (points 2 and 3, R. Br. 2-4).

(a) The suggestion of prematurity is contrary to the record. The Court of Appeals has *twice*, without qualification, denied the relief now sought.[2] That Court has nonetheless recognized that petitioner should not be required to deal **de novo** on appeal with information and arguments of which he was not timely notified and had no opportunity to meet below, *at least* until after all attempts to obtain a fair hearing have been exhausted—and has accordingly *stayed* petitioner's obligation to file a brief on the merits on several occasions,[3] most recently until

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[1] [Continued]

In the circumstances, the Court would be more than justified in proceeding along lines analogous to the treatment afforded similarly remiss litigants in the lower federal courts, and dealing with the petition *independently of respondent's arguments* on the ground that respondent has forfeited the right to be heard by its own dilatory conduct.

[2] Specifically, through a two-judge panel on September 23, 1974, (Pet. 1a) and, *en banc*, on October 18, 1974 (Pet. 2a). In neither case did that court suggest that the denial was "without prejudice" or otherwise qualified so as to afford petitioner an opportunity of pressing for the same relief in a brief on the merits of the appeal.

[3] Petitioner's obligation to file a brief on the merits was held in abeyance during pendency of the motion for summary reversal denied September 23, 1974 (Pet. 1a) notwithstanding respondent's opposition based on the argument that "the motion for summary reversal and the merits raise interrelated issues which can best be disposed in a single proceeding. . . ." (Opposition to Appellant's motion for stay of proceedings" filed below in Appeal No. 74-1365 on June 7, 1974). Appellant was granted a further extension of time, again over respondent's opposition until "20 days from the date of this Court's ruling on appellant's [i.e., petitioner's] pending

"20 days from the date of disposition by the Supreme Court of the Petition for Certiorari pending in Supreme Court No. 74-620".[4]

The issues raised for review by this petition are now ripe for certiorari review on the same rationale which governs the ripeness for appellate review of collateral orders. The refusal of the district judge to recuse himself and vacate his tainted decision on the merits is an action which falls ". . . in that small class which finally determine claims of right separate from and collateral to, rights asserted in the action, too important to be denied review and too independent of the cause itself to require that appellate consideration be deferred until the whole case is adjudicated." *Cohen* v. *Beneficial Industrial Loan Corp.*, 337 U.S. 541, 546 (1949).

Having been deprived by the district court's improper and irregular conduct of the opportunity to make an appropriate record on which to stand, peti-

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petition for rehearing *en banc*." Respondent's opposition served October 9, 1974 was again on the basis that "the issues raised. . . can be resolved most expeditiously in the context of an appeal on the merits." After the appellate court's denial of the petition for rehearing *en banc* (Pet. 2a) petitionr moved for an extension of time to November 22, 1974 expressly stating his intention to file this petition on or before that date. That motion, which respondent did *not* oppose, was granted as of October 15, 1974 over the handwritten initials of the chief judge of the District of Columbia Circuit. Upon the filing of the petition in this court, petitioner's further motion to extend the time until 20 days after this Court's action thereon was filed and granted on December 6, 1974—again without opposition from respondent.

In short, the prematurity argument is one on which respondent was uniformly unsuccessful, and which respondent ultimately abandoned, in the court below. The argument merits no greater success here.

[4] The quotation is from the December 6, 1974 order of the Court of Appeals.

tioner is disabled to obtain a fair hearing on the merits of the appeal from the district court's tainted order on the merits. Hence, review *now* is appropriate in the interests of justice, including judicial economy.

(b) Respondent's efforts to show that the district court had discretion to proceed as it did (R. Br. 2-4) are misdirected on this petition for certiorari and are not cognizable on the question of whether certiorari should be granted. Rather, they are a mere preview of what respondent will say if the case is accepted to be heard on the questions raised by the petition.

The attempted reliance upon the district judge's self-serving characterization of the *ex parte* off-the-record consultation between his staff and respondent as a "physical identification of material" (Pet. 19a) is directly contradicted

> (i) by respondent's own confession that the consultation resulted, *inter alia*, in a holding "that non-final manuscript opinions do not fall within the categories of 5 U.S.C. 552(a)(2)(B) and (C)" (R. Br. 3). There is no pretext in either of the district court's memorandum orders of January 10, 1974 (Pet. 3a) and March 11, 1974 (Pet. 16a) that *unbound* post-1967 manuscript decisions were "physically inspected". The acknowledgement that the district court, in the January 10 memorandum order, ruled upon how their content should be categorized is hence an *a fortiori* admission that the *ex parte* off-the-record consultation involved *far more* than "identification of material" and included *at least* advocate's arguments and representations as to

how this and other controverted matters should be dealt with by the district judge.[5]

(ii) respondent's non-too-subtle acknowledgement that even though it *failed* to "counter petitioner's 'statement of material facts as to which there is no genuine issue'" (R. Br. 4) *on the record*, "it would have been exalting form above substance [for the district court] to accept that statement of facts as dispositive on the record as it stood" (R. Br. 4). The implication is that since the government neglected to respond to or counter petitioner's statement, the district court's own off-the-record, *ex parte* excursion to investigate the material facts so as to afford a basis for disposing of the unopposed motion *adversely* to petitioner was not only understandable but justified.

Even if it *were* accurate, moreover, the characterization could not exculpate the district court's impropriety. The Code of Judicial Conduct contains no exception for judges who function as material witnesses in the "physical identification of materials." The attempted exculpation *ignores* the *ex parte* consultation and discussion accompanying the alleged "inspection", details of which have been carefully suppressed by respondent and the district court but which obviously strongly influenced the rulings.

The incorrect representation that "any facts . . . determined as a result of . . . [the ex parte off-the-record consultation between respondent and the district court's employee] were fully supported by the record in this case,

[5] The district court's own March 11, 1974 memorandum-order itself confesses that the purpose of the *ex parte*, off-the-record consultation was "to gain a better perspective on the materials actually in issue" (Pet. 17a) thereby admitting that far more than "physical inspection" was at stake.

or were undisputed and available, upon request, to any member of the public, or were found in petitioner's favor" (R. Br. 3) was first made by respondent in opposition to petitioner's motion in the district court to vacate the January 10, 1974 memorandum order, to recuse the district judge and to reopen proceedings for a full and fair hearing before a different judge.[6] Plaintiff's reply memorandum in the district court filed March 11, 1974 took issue with this representation as *"not true"*[7] and presented specific reasons detailing its inaccuracy.[8] Respondent's effort *now* to defend the district judge's conduct "as in no way improper" (R. Br. 3) is strikingly at odds with respondent's own interrogatory answer reproduced in the March 11, 1974 memorandum order (Pet. 19a) which denominated even the suggestion that respondent might have consulted *ex parte* with the district judge or his staff as one "which impugns the integrity of both the Court and counsel."[9]

(2) Respondent has not mentioned the fact, though it should have done so, that subsequent to the November

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[6] See the Appendix in No. 74-1365, copy of which has been lodged with the Clerk, at 207 where the same misrepresentation by respondent appears.

[7] Id at 212.

[8] Id at 212-217.

[9] Respondent's belated suggestion in this Court that "other Patent Office officials" than its sole affiant Martin could have been examined on Martin's affidavit again confesses the essential unfairness of the proceeding below. Even after Martin's first affidavit was clearly shown to be false (Pet. 8-9) that affidavit was not withdrawn but was instead supplemented by a second affidavit of Martin which did not even trouble to correct or explain the first (Pet. 9). No other "official" was offered or suggested as a substitute witness at any time.

Even more importantly, no authority cited by respondent or known to petitioner condones the proposition that the government may select as its affidavit witness on controverted matters one of its own lawyers and then immunize him from cross-examination because he is counsel.

20, 1974 filing of the petition in this case, on December 5, 1974, the President signed into law a statute amending 28 USC 455 having as its purpose "to broaden and clarify the grounds for judicial disqualification" [10] and incorporating therein the substance of Judicial Canons 2 and 3.

Under 28 USC 455 as thereby amended, a judge with "personal knowledge of disputed evidentiary facts" (Subsection (b)(1, p. 2a, *infra*) *must* in future cases disqualify himself (See subsection (e), p. 4a, *infra*).[11] If the decision below is allowed to stand, it will sufficiently blunt the force of the statutory language to provide the unscrupulous with an exception from the statute's mandate for instances when "physical identification of material" is allegedly at stake and will allow those relatively few judges who are bent on staying just at the line between ethical and unethical judicial conduct a basis for drawing that line at a different point from what the statute intends.[12]

(3) This Court's decision in *Goss* v. *Lopez*, No. 73-898, rendered January 22, 1975 affords a further reason for

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[10] See pp. 1a to 4a, *infra*, wherein the statute as adopted is reproduced.

[11] Note that section 3 of the statute (*infra*, p. 4a) specifically excludes cases pending at its enactment from its reach.

[12] Compare the Second Circuit's observation in *General Motors Corp.* v. *City of New York*, 501 F.2d 639, 649, decided June 28, 1974, that

> ". . . the Code of Professional Responsibility is not designed for Holmes' proverbial 'bad man' who wants to know just how many corners he may cut, how close to the line he may play, without running into trouble with the law. Holmes, *The Path of the Law*, in Collected Legal Papers 170 (1920). . . ."

It is timely for the lower federal judiciary to be made aware that the Code of Judicial Conduct and its statutory embodiment for future cases in amended 28 U.S.C. 455 are similarly *not* so designed.

the grant of review in this case. The lower courts should be clearly informed that *bona fide* litigants attempting to avail themselves of rights guaranteed by the Freedom of Information Act are at least equally entitled to due process and a fair hearing with public school students suspended for periods of up to ten days because of minor disciplinary infractions.

Respectfully submitted,

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296-8855

Attorney for Petitioner

February 3, 1975

APPENDIX

APPENDIX

Union Calendar No. 697

93D CONGRESS
2D SESSION

S. 1064

[Report No. 93-1453]

IN THE HOUSE OF REPRESENTATIVES

OCTOBER 9, 1973

Referred to the Committee on the Judiciary

OCTOBER 9, 1974

Reported with amendments, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

[Omit the part in brackets and insert the part printed in italic]

AN ACT

To improve judicial machinery by amending title 28, United States Code, to broaden and clarify the grounds for judicial disqualification.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 455 of title 28, United States Code, is amended to read as follows:

"§ 455. [Disqualification of justice or judge] *Disqualification of justice, judge, magistrate, or referee in bankruptcy*

"(a) Any justice, judge, [or] magistrate, *or referee in bankruptcy* of the United States shall disqualify himself in any proceeding in which his impartiality might reasonably be questioned.

"(b) He shall also disqualify himself in the following circumstances:

"(1) where he has a personal bias or prejudice concerning a party, or personal knowledge of disputed evidentiary facts concerning the proceeding;

"(2) where in private practice he served as lawyer in the matter in controversy, or a lawyer with whom he previously practiced law served during such association as a lawyer concerning the matter, or the judge or such lawyer has been a material witness concerning it;

"(3) Where he has served in governmental employment and in such capacity participated as counsel, adviser or material witness concerning the proceeding or expressed an opinion concerning the merits of the particular case in controversy;

"(4) He knows that he, individually or as a fiduciary, or his spouse or minor child residing in his household, has a financial interest in the subject matter in controversy or in a party to the proceeding, or any other interest that could be substantially affected by the outcome of the proceeding;

"(5) He or his spouse, or a person within the third degree of relationship to either of them, or the spouse of such a person:

"(i) Is a party to the proceeding, or an officer, director, or trustee of a party;

"(ii) Is acting as a lawyer in the proceeding;

"(iii) Is known by the judge to have an interest that could be substantially affected by the outcome of the proceeding;

"(iv) Is to the judge's knowledge likely to be a material witness in the proceeding.

"(c) A judge should inform himself about his personal and fiduciary financial interests, and make a reasonable effort to inform himself about the personal financial interests of his spouse and minor children residing in his household.

"(d) For the purposes of this section the following words or phrases shall have the meaning indicated:

"(1) 'proceeding' includes pretrial, trial, appellate review, or other stages of litigation;

"(2) the degree of relationship is calculated according to the civil law system;

"(3) 'fiduciary' includes such relationships as executor, administrator, trustee, and guardian;

"(4) 'financial interest' means ownership of a legal or equitable interest, however small, or a relationship as director, adviser, or other active participant in the affairs of a party, except that:

"(i) Ownership in a mutual or common investment fund that holds securities is not a 'financial interest' in such securities unless the judge participates in the management of the fund;

"(ii) An office in an educational, religious, charitable, fraternal, or civic organization is not a 'financial interest' in securities held by the organization;

"(iii) The proprietary interest of a policyholder in a mutual insurance company, of a depositor in a mutual savings association, or a similar proprietary interest, is a 'financial interest' in the organization only if the outcome of the proceeding could substantially affect the value of the interest;

"(iv) Ownership of government securities is a 'financial interest' in the issuer only if the outcome of the proceeding could substantially affect the value of the securities.

"(e) No justice, judge, [or] magistrate, or *referee in bankruptcy* shall accept from the parties to the proceeding a waiver of any ground for disqualification enumerated in subsection (b). Where the ground for disqualification arises only under subsection (a), waiver may be accepted provided it is preceded by a full disclosure on the record of the basis for disqualification."

SEC. 2. Item 455 in the analysis of chapter 21 of such title 28 is amended to read as follows: ["Disqualification of justice or judge."] *"Disqualification of justice, judge, magistrate, or referee in bankruptcy."*

SEC. 3. This Act shall not apply to the trial of any proceeding commenced prior to the date of this Act, nor to appellate review of any proceeding which was fully submitted to the reviewing court prior to the date of this Act.

Passed the Senate October 4, 1973.

Attest:

FRANCIS R. VALEO,
Secretary.